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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,874	11/17/2000	Carl M. Sullivan	30222/20:100	7638
3528	7590	01/09/2006	EXAMINER	
STOEL RIVES LLP 900 SW FIFTH AVENUE SUITE 2600 PORTLAND, OR 97204-1268			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,874

Applicant(s)

SULLIVAN ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-11,18,19,21-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-11,18,19,21-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed January 28, 2005.
Claims 1, 18, 22-23, 25, 27-29 were amended rendering claims 1-2, 4-5, 8-11, 18-19, 21-23 and 25-29 pending. The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference(s) to Busby et al (U.S. 4,127,685). Rejections based on the newly cited reference(s) follow.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 18 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 18 and 22, the phrases, "wherein the film has a flexibility suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" and "such that only one layer melts and

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seals to itself even when heat is transferred through the other layer" is not supported by the specification.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, 8-11, 18-19, 21-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Greenlee (U.S. 5,248,546) in view of Busby et al (U.S. 4,127,685).

Greenlee discloses a multilayered article comprising a first layer of polyvinyl chloride and a second layer of polyvinyl chloride, which are adjacent to each other (column 2, lines 17-45) where the PVC compounds contain plasticizers (column 5, lines 8-14). Greenlee discloses the PVC containing layers comprise antistatic agents having levels less than 20phr(column 6, lines 44-55) which is a surface reactive agent. The reference discloses the plasticizer ranges from 0.5 to 10 phr (column 5, lines 56-65). Greenlee discloses along with the addition of plasticizers, copolymers can be incorporated in the layers as well (column 6, lines 20-26) such as polyester adipates (column 14, line 56 through column 15, line 5). In instant claim 18, 'a total thickness of up to 2 mil' equates to 0mil, which is met by the prior art reference. The reference

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discloses the second layer is at least three degrees Celsius higher than the heat distortion temperature (melting point) of the first layer (column 2, lines 36-40). In instant claim 3, the phrase, 'promotes ambient or latent moisture' constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. Additionally, in instant claim 3, '...to uniformly spread on the surface of the film' is held to be a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Greenlee does not show that the at least two layers have different gas permeabilities as in instant claims 28 and 29. However, such gas permeabilities are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the gas permeabilities, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. gas permeabilities) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the breathability and integrity of the multilayered PVC article. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the

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multilayered PVC article with the limitations of the gas permeabilities since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Although Greenlee does not refer to the article specifically as a packaging film, it is obvious to the average artisan that a sheet can be used as a liner for packaging materials, which is further supported where Greenlee discloses the multilayered article is acceptable for direct food contact (column 3, lines 1-5) which has the same function and capability as a packaging film. Greenlee does not explicitly disclose the plasticizer comprising soya bean oil.

Busby teaches a packaging film made from PVC material and a plasticizer such as epoxidized soya bean oil (column 1, lines 21-32 and column 2, lines 56-62). Therefore, it would have been obvious to one of ordinary skill in the art to have employed the epoxidized soya bean oil plasticizer, as taught in Busby, in the packaging film of Greenlee because the epoxidized soya bean oil material provides improved adhesion of the film (column 2, lines 56-66).

Response to Arguments


6. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Greenlee (U.S. 5,248,546) are considered moot based on grounds of new rejection.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
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